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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/961,052	09/24/2001	Hirokazu Tanaka	K-1827CON	6719

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EXAMINER	
CHOI, FRANK I	
ART UNIT	**PAPER NUMBER**
1616	4

DATE MAILED: 12/18/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/961,052	Applicant(s) TANAKA ET AL.	
	Examiner Frank I Choi	Art Unit 1616	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 September 2003* .

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-8 and 10-21* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-8 and 10-21* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☒ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. *09/319,176* .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: .

DETAILED ACTION

Specification

The Specification and claims 2,3,10,11 refer to JIS Z 8730. The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).

Examiner has duly considered Applicant's arguments but deems them unpersuasive.

The fact that the parent application makes reference to JIS Z 8730 does not overcome the rejection as incorporation by reference to a U.S. patent or application which itself incorporates "essential material" by reference is not permitted. See MPEP Section 608.01(p)(I). Further, it is noted that JIS Z 8730 6.3.2 itself refers to JIS Z 8722 and requires that L, a and b are calculated as specified in JIS Z 8722.

Claims 2,3,10,11 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 2, 3,10,11 refer to JIS Z 8730 which renders the claims ambiguous as industrial standards are subject to change, as such, one of ordinary skill in the art would be in doubt as to which version of JIS Z 8730 should be used to arrive at the appropriate color difference.

Examiner has duly considered Applicant's arguments but deems them unpersuasive.

Applicant's submission of JIS Z 8730-1980 supports the assertion that industrial standards are subject to change (See last page of JIS Z 8730-1980).

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claims 1-6 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 48-29528.

JP 48-29528 expressly discloses the preparation of pigments coated with silicic acid falling within the scope of applicant's claims (Column 3, Example 1, Column 3, 4, Example 3.

Alternatively, at the very least the claimed invention is rendered obvious within the meaning of 35 USC 103, because the prior art discloses methods of manufacturing which using pigments and silicic acid as that of the claimed invention. See In re Fitzgerald, 205 USPQ 594 (CCPA 1980). See also In re May, 197 USPQ 601, 607 (CCPA 1978). See also Ex parte Novitski, 26 USPQ2d 1389, 1390-91 (Bd Pat. App. & Inter. 1993). Because the prior art process

uses a silicic acid coating, said pigments prepared by the prior art process will have a refractive index of at most 1.8 and exhibit a Hunter's color difference in the range of 55 to 84%.

Examiner has duly considered Applicant's arguments but deems them unpersuasive. Applicant refers to the article "The chemistry of silica" and indicates that the silicic acid solution is different from silicic acid or silicate. However, Applicant presents no evidence which supports the conclusion that the "silicic acid solution" as used in the article is the same as the "silicic acid solution" as used in the Specification. Further, Applicant's claims do not exclude the heating and cooling as manufacturing steps and in fact Applicant's own examples utilize heating and inherently cooling as process steps.

Claims 1-8 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over JP 60-228406.

JP 60-228406 expressly discloses the preparation of pigments coated with silicic acid which are used in cosmetics falling within the scope of applicant's claims (See entire reference, especially pages 3-6).

Alternatively, at the very least the claimed invention is rendered obvious within the meaning of 35 USC 103, because the prior art discloses methods of manufacturing which using pigments and silicic acid as that of the claimed invention. See In re Fitzgerald, 205 USPQ 594 (CCPA 1980). See also In re May, 197 USPQ 601, 607 (CCPA 1978). See also Ex parte Novitski, 26 USPQ2d 1389, 1390-91 (Bd Pat. App. & Inter. 1993). Because the prior art process uses a silicic acid coating, said pigments prepared by the prior art process will have a refractive index of at most 1.8 and exhibit a Hunter's color difference in the range of 55 to 84%.

Examiner has duly considered Applicant's arguments but deems them unpersuasive.

Applicant argues that JP'406 does not use silicic acid solution to deposit the silica layer on the particles. However, Applicant own arguments show that a silicic acid solution is used to deposit the silica layer on the particles (Response, Pg. 10).

Claims 10-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schmid et al. (US Pat. 5,607,504) in view of Nishihara et al. (US Pat. 5,017,231).

Schmid et al. teaches a method of preparing pigments by dispersing in organic silicon and/or aluminum compounds, such as, aluminum triisopropoxide and tetraethoxysilane, in which the organic radicals are hydrolyzed, with the resulting coating having a refractive index of 1.8 or less (Column 5, lines 1-62). It is taught that the pigments can be used in cosmetic preparations (Column 7, line 46).

Nishihara et al. teaches a method of preparing pigments by dispersing in organic silicon and/or aluminum compounds, such as aluminum triisopropoxide and silicon tetramethoxide, in which the metal alkoxide is hydrolyzed wherein the hydrated oxide of the corresponding metal is deposited onto the pigment, which pigments exhibit improved heat resistance, weatherability, light fastness and chemical stability, wherein color difference is by the method of JIS Z8730 (Columns 1-4).

The difference between the prior art is that the prior art does not expressly disclose methods of preparation of pigments and cosmetics by adding a hydrolytic organic silicon compound or organic aluminum compound to a dispersion of pigment particles, where the resultant surface as a refractive index of at most 1.8, where the pigment particles have a decrease rate of color difference defined by Hunter's color difference formula define in 6.3.2 of JIS Z 8730 in the range of 55 to 84%. However, the prior art amply suggests the same as methods of

preparing pigments having coatings with refractive index of 1.8 or less and in which color differences are measured according to JIS Z 8730, which coatings are prepared from hydrolytic organic silicon and aluminum compounds are known in the art. As such, it would have been well within the skill of and one of ordinary skill in the art would have been motivated to modify the prior art as above with the expectation that the resultant pigment would be physically and chemically stable.

Examiner has duly considered Applicant's arguments but deems them unpersuasive.

In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Further, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981). Contrary to Applicant's arguments, Nishihara et al. does disclose a decreased rate of color difference as indicated above.

Therefore, the claimed invention, as a whole, would have been *prima facie* obvious to one of ordinary skill in the art at the time the invention was made, because every element of the invention has been collectively taught by the combined teachings of the references.

Conclusion

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

A facsimile center has been established in Technology Center 1600. The hours of operation are Monday through Friday, 8:45 AM to 4:45 PM. The telecopier number for accessing the facsimile machine is (703) 872-9306.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Frank Choi whose telephone number is (703) 308-0067. Examiner maintains a flexible schedule. However, Examiner may generally be reached Monday-Friday, 8:00 am – 5:30 pm (EST), except the first Friday of the each biweek which is Examiner's normally scheduled day off.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's Supervisor, Mr. Thurman Page, can be reached on (703) 308-2927. Additionally, Technology Center 1600's Receptionist and Customer Service can be reached at (703) 308-1235 and (703) 308-0198, respectively.

FIC
December 12, 2003

JOHN PAK
PRIMARY EXAMINER
GROUP 1600